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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,006	07/18/2003	Val Krukonis	07678/116002	4588

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CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

EXAMINER

LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
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1791

NOTIFICATION DATE	DELIVERY MODE
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11/26/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentadministrator@clarkelbing.com

Office Action Summary	Application No. 10/623,006	Applicant(s) KRUKONIS ET AL.	
	Examiner CARLOS LOPEZ	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16 and 18-37 is/are rejected.
- 7) ☒ Claim(s) 15, 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

The rejection of the previous office is withdrawn in view of newly cited art.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-27 and 29-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 22-24, the phrase “said vessel” makes it unclear to which vessel is being referred. Is it the vessel recited in step b, or the separator vessel?

In claims 25-27, the phrase “said tobacco” makes it unclear to which tobacco is being referred. Is it the tobacco of step a, b, or c?

In regards to claims 29-30, the phrase “said tobacco” makes it unclear which tobacco is being referred to. Is it the tobacco recited in step a, b, or c?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-14, 16, 18-24, 28, 31-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Muller (US 4,506,682). Muller discloses providing a vessel 4 comprising

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tobacco (see Abstract), contacting the tobacco with sub-critical carbon dioxide (see Col. 3, lines 8ff), and removing the fluid from the vessel to extract a component (tobacco aroma oil) from the tobacco (see abstract).

As for claims 2-5, each specifying a component of the extracted material, it is deemed that, in view of Muller contacts the tobacco under the substantially the same sub-critical conditions (See Muller Col. 3-4) as disclosed by applicant such as temperature range, pressure range, ratio of carbon dioxide to tobacco, and treatment time, it would be inherent that the claimed specific components would also be extract from Muller's treated tobacco.

As for step d of claim 5 and claim 7, the fluid from vessel 4 is directed to vessel 10.

As for claim 6, the vessel 4 would be "isolated" when taking out the extracted tobacco as noted in Col. 7, lines 25ff.

As for claims 8-10, the fluid contacting the tobacco is described by Muller as being a gas and a liquid (Col. 7, lines 32).

As for claims 11-13, the sub-critical fluid comprising tobacco components are separated by a heat-exchanger and expansion vessel 10. (See Col. 7, lines 39ff) The component, tobacco aroma oil, would comprise of the claimed PAH in view that it is obtained by similar process conditions set forth by applicant's specification.

As for claims 14,16, and 18-21, separator vessel is deemed as heat exchanger 9 wherein the substance capable of separating the constituent tobacco oil is deemed as the cooling fluid of the heat exchanger wherein the temperature of the sub-critical is

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lowered to in order to precipitate the constituent dissolved in the sub-critical fluid (See Col 7, lines 37ff).

As for claims 22-24, the sub-critical fluid is re-circulated back to the vessel 10, deemed as the vessel used in step B of applicant's claims. (See Col.7, lines 47ff)

As for claim 28, see above.

As for claims 31-32, it would be inherent that the claimed components would comprise the tobacco aroma oil extracted by Muller in view that the tobacco is treated under substantially the same process conditions as applicant.

As for claims 33-37, see above.

Allowable Subject Matter

Claims 15 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARLOS LOPEZ whose telephone number is (571)272-1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carlos Lopez/
Primary Examiner
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